

Attorney Docket No.: 9389-11
Application No.: 10/738,547
Filed: December 17, 2003
Page 12 of 17

REMARKS

This Response is submitted in reply to the Office Action mailed September 8, 2004 ("the Action"). Claims 1-59 are pending in the application but Claims 3, 5, 7, 8, 22, 23, 47 and 48 are withdrawn from consideration as directed to a non-elected (species) of the invention. Applicants hereby confirm that the species of Figure 3 is elected. Claims 6-10, 24-27 and 49-52 are directed to this species. Applicants reserve the right to prosecute the other species in future divisional applications without importing any prosecution limitations for the elected species.

I. The §112, Second Paragraph Rejections

Claim 59 has been amended to depend from Claim 57 to obviate the antecedent basis issue. Applicants respectfully request that this rejection be withdrawn.

II. U.S. Patent No. 6,729,102

Certain of the claims stand rejected as being anticipated by or obvious in view of U.S. Patent No. 6,729,102 to Ailey et al. ("Ailey"). However, the pending application is a continuation-in-part of Ailey.

Applicants are attaching a copy of the Preliminary Amendment filed via facsimile on April 14, 2004, within four months of the filing date of the instant application (filed December 17, 2003), which corrected the priority claim for the instant application. A copy of the USPTO "Auto Reply" confirming receipt of this Preliminary Amendment is also attached. As stated in the Preliminary Amendment, the instant application is a continuation-in-part of U.S. Patent Application Serial No. 10/339,910, now U.S. Patent No. 6,729,102, which corresponds to Publication No. 2003-0131564A1 to Ailey et al. ("Ailey"). As such, Applicants respectfully submit that Ailey is not a prior art reference for the pending application and request that the rejections citing Ailey be withdrawn. Alternatively, Applicants respectfully request that the rejections citing Ailey be held in abeyance pending entry of the priority claim stated in the Preliminary Amendment.

Applicants also request that a new corrected filing receipt reflecting the proper priority

Attorney Docket No.: 9389-11
Application No.: 10/738,547
Filed: December 17, 2003
Page 13 of 17

claim be issued. In the alternative, Applicants request that this be considered a petition to correct the priority claim to the earlier date. The Examiner's assistance in correcting this priority claim is requested.

III. U.S. Patent No. 3,945,171 to Marietta, Jr. et al. ("Marietta")

A. The 102(b) Rejections

The Action states that Claims 1, 2, 4, 6-10, 14, 20, 21, 24-27, 31, 38, 39, 41, 44-46 and 49-52 are rejected as anticipated by Marietta. The Action states that Marietta shows a "product chute 14 with a flared upstream end 12 through which the product is fed and then periodically clipped to form individual packages." The Action goes on to state that the "chute comprises a tubular body with [an] interior generally oval shape with planar floor supported by bracket 13."

Marietta proposes a chute with an open top that allows an operator to load product into the chute. Marietta states that the horn H is characterized by "an upwardly and rearwardly opening funnel-like receiving end portion 12" (col. 3, lines 68-69 and col. 4, lines 1-4) (emphasis added). See Figure 1 feature "I" above open "funnel" 12. Also, Figure 6 clearly illustrates that Marietta teaches the use of a horn without a ceiling in its forward receiving portion 12. The open ceiling allows an operator to "drop" product into the horn. In contrast, in some embodiments, the ceiling of the flared or funnel-like forward portion of the instant invention is generally continuous (*i.e.*, generally closed so that product is moved into the chute axially rather than orthogonally).

Claim 1 recites in-part:

wherein the chute comprises a primary body and an entry segment disposed upstream thereof, the entry segment having a flared portion with a first cross-sectional area that tapers into an adjacent downstream portion proximate the primary body to have a smaller second cross-sectional area thereat, and wherein the flared portion comprises a generally continuous ceiling.

Claim 20 recites in-part:

Attorney Docket No.: 9389-11
Application No.: 10/738,547
Filed: December 17, 2003
Page 14 of 17

an elongate product chute having a generally planar floor and an outer wall defining opposing receiving and discharge end portions and an interior cavity extending therethrough, the cavity having a non-circular cross-sectional shape, wherein the chute further comprises a flared entry segment with a first cross-sectional area that tapers into an adjacent downstream portion to have a smaller second cross-sectional area thereat...

Claim 41 recites in-part:

pushing at least one object through a product chute having a floor and a non-circular cross-sectional shape, wherein the chute comprises a primary body and a flared entry portion with a first cross-sectional area that tapers into an adjacent downstream portion proximate the primary body to have a smaller second cross-sectional area thereat...

In view of the above, Applicants respectfully submit that the claims are patentable over the cited references.

B. The 103 Rejections

The Action states that Claims 11-13, 15-19, 28-30, 32-37, 40, 42, 43 and 5-59 are obvious over Marietta. The Action states that the use of angled chutes (Claims 11, 28 and 53), contoured supporting recesses (Claims 15, 32), handles (Claims 18, 35), sensors (Claims 17, 34 and 56), releasable brackets (Claims 37, 55) "are well known in the art" and their use "in the Longo operation would have been obvious to one of skill in the art for their inherent and known advantages." Applicants respectfully disagree.

Angled Chute

U.S. Patent No. 3,815,323 to Longo ("Longo") is directed to a garbage compactor. Longo uses a tubular body 10 with a generally circular cross-section. Longo has a straight discharge configuration. Marietta also shows only a straight discharge profile. Neither of the references teach or suggest the angled chute feature as recited in Claims 11, 28, 53 and new Claim 61. Applicants respectfully request that the Examiner support the statement that such a feature is "well known in the art" by providing a citation for same.

Attorney Docket No.: 9389-11

Application No.: 10/738,547

Filed: December 17, 2003

Page 15 of 17

Releasable Brackets, Sensors, Handle

Longo describes a dedicated body 10 that is configured to remain in position rather than to be replaced during normal operation. Marietta appears to also describe a dedicated horn, as the side bracket 13 appears to be welded to the sides of the funnel section 12. In contrast, embodiments of the present invention are directed to providing easily interchangeable chutes. Neither Longo or Marietta teach or suggest configuring a handle on the chute (Claims 18, 35 and new Claim 60), configuring the chute with releasable matable brackets (Claims 37, 55 and new Claim 62), or the use of position confirming sensors (Claims 17, 34, 56 and new Claims 63, 66) for ensuring that a chute is in a desired position before allowing operation.

Contoured Supporting Recesses

Longo describes supporting the body 10 so that the forward portion of the body extends "cantilevered over the base support 12" (col. 3, lines 35-4). Referring to Figure 1 of Longo, the base 12 is firmly attached to the underside of the body 10. Pivoting hinged arms 64 extend over the tube and merge down onto the tube to hold the bag (col. 7, lines 45-65). Figures 1 and 6 of Marietta show an integral bracket 13 that rises from the floor of the device. Neither of these references teach or suggest using contoured supporting recesses or other of the claimed bracket features (Claims 14, 15, 16, 31, 32, 33, 55 and new Claims 64 and 65).

In view of the foregoing, Applicants respectfully submit that the dependent and new independent claims are independently patentable for at least these reasons.

IV. Request for more particular citation to references

Applicants respectfully request that the Examiner provide support for the rejections of the claims described in Section III.B. above. That is, the rationale used in the Action to reject the claims discussed in section III.B of this response is legally incorrect, as it employs impermissible conclusory and/or subjective rationale to support the obviousness of the claims. It is incontrovertibly improper to employ subjective rationale in an obviousness

Attorney Docket No.: 9389-11
Application No.: 10/738,547
Filed: December 17, 2003
Page 16 of 17

rejection. As stated by the Federal Circuit in In re Sang-Su Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), when the issue is obviousness, there must be specificity and particular findings based on evidence. It is improper to simply use the teachings of the application against the applicant. The factual question of motivation is material to patentability and is not to be resolved on subjective belief and unknown authority. *Id*

Accordingly, if the Examiner remains unpersuaded as to the patentability of the claims discussed in Section III.B, Applicants respectfully request that the Examiner provide a citation to a prior art document and passages therein in support of the obviousness rejections.

V. Hindsight

The Action appears to employ hindsight reasoning to conclude that the claimed subject matter of the present invention is obvious. Further, the fact that the invention employs known elements does not preclude patentability. It is the claimed combination of elements which is the proper basis for review. "Virtually all inventions are necessarily combinations of old elements." *Panduit* at 1575 (citing *Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 220 USPQ 97, 99-100 (Fed. Cir. 1983)). Indeed, the Federal Circuit has stated (in regard to an obviousness-type invalidity challenge to an issued patent) that "[t]he notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, §103." *Panduit* at 1575. Further, simplicity alone cannot be determinative of obviousness. *Gentry Gallery, Inc. v. Berkline Corp.*, 45 USPQ2d 1498 (Fed. Cir. 1998).

Applicants submit that while it is true that some of the claim elements are in different prior art references, it is the combination of claimed elements that provides the patentability of the claimed invention. Applicants respectfully submit that absent the teachings of the instant invention, one of skill in the art would not have combined the references in a way that would render the claimed invention obvious.

Attorney Docket No.: 9389-11
Application No.: 10/738,547
Filed: December 17, 2003
Page 17 of 17

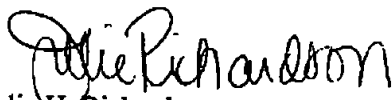
VI. References "not considered"

Applicants submitted a Form 1449 on March 18, 2004, which listed one (1) patent reference and four (4) non-patent references. The Examiner refused to consider the non-patent references (nos. 2-5 thereon), as they were "not received." However, Applicants submitted the references with the Information Disclosure Statement ("IDS"); a copy of the stamped itemized post card (noting the attachment of the 5 references) received back from the USPTO confirming such receipt is attached. Nonetheless, Applicants are attaching copies of these references (and a duplicate copy of the cover sheet of the IDS) with this response. Consideration of same and return of an initialed Form PTO 1449 confirming same is requested.

VII. Conclusion

Applicants submit that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

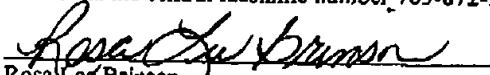
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CERTIFICATION OF FACSIMILE TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office via the central facsimile number 703-872-9306 on November 22, 2004.


Rosa Lee Brinson